

RESPONSE TO RESTRICTION REQUIREMENT

The Office imposes two election requirements. The first is between Species A and Species B, in which:

Species A is the asynchronous transmission embodiment; and

Species B is the synchronous transmission embodiment.

The second is between Species a and Species b, in which:

Species a uses frequency division multiplexing; and

Species b uses time division multiplexing.

In response to the election requirements, Applicants elect, with traverse, to prosecute:

Species A, i.e., those reading on asynchronous transmission. Applicant identifies these as claims 1-7, 9-22, and 24-44. (Claims 1-6, 9-21, and 24-44 are generic to both species.)

Species a, i.e., those employing frequency division multiplexing. Applicant identifies these as claims 1-9, 11-24, and 26-44. (Claims 1-8, 11-23, and 26-44 are generic to both species.)

Because Applicant has elected one of the groups as defined by the Office and identified the claims therein, this paper is fully responsive.

For an election among species to be proper, the species must be patentably distinct. M.P.E.P. §806.04(h). Applicant therefore notes the Office's implied concession in imposing the restriction requirement that the species not obvious variants over one another. Applicant also notes that if the generic independent claims are allowed, then the non-elected claims must be rejoined. M.P.E.P. §821.04.

Applicant traverses the election requirement because (1) the case has not been properly made, and (2) it is contrary to Office policy. Applicant agrees that restriction in this case is governed by unity of invention practice under PCT Rule 13.1. *See* M.P.E.P. §§1850, 1893.03(d). Furthermore, unity of invention "should be considered with respect to novelty and inventive step" M.P.E.P. §1850 II.

However, the Office here failed to even explain whether the novelty or inventive step is the issue, much less to actually apply any of the three cited references. Office policy requires such an explanation:

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims *and* (2) *explain why each group lacks unity with each other group* (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

M.P.E.P. §1893.03(d) (emphasis added). Thus, the Office has failed to establish that there is no special technical feature contrary to stated policy.

There consequently also is no unity of invention problem because the requirement if for election among species found in dependent claims:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims.

M.P.E.P. §1893.03(d). Applicant respectfully submits that the independent claims are novel and possess inventive step over the cited art. At a minimum, the Office failed to properly establish to the contrary. Accordingly, the election requirements are improper.

The Examiner is invited to contact the undersigned attorney at 713.934.4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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